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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,061	04/26/2001	Nancy Elisabeth Krauss	R0070B-REG	9572

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INTELLECTUAL PROPERTY LAW DEPT., MS A2-250
PALO ALTO, CA 94304-9819

EXAMINER

LIU, HONG

ART UNIT PAPER NUMBER

1624

DATE MAILED: 09/06/2002

Y

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/844,061

Applicant(s)
Krauss et al.

Examiner
Hong Liu

Art Unit
1624

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

THE REPLY FILED Aug 6, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached advisory action.

3. ☒ Applicant's reply has overcome the following rejection(s):
112, first paragraph rejection, 102(b), the Barton reference, the Okada reference, the Billman reference, the Katrizky reference.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____
- Claim(s) objected to: 6-11, 14-19, and 38-43
- Claim(s) rejected: 1-5, 12, and 13
- Claim(s) withdrawn from consideration: 50-56
8. ☐ The proposed drawing correction filed on _____ is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other:

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Attachment to the Advisory Action

Applicant response in paper No. 7 is hereby acknowledged. Claims 1-56 are pending in this application.

The amendment filed on August 6, 2002 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: Rejection to claims 1-5, 12, and 13 under 35 U.S.C. 103(a) as being unpatentable over Dinsmore et al. (Bioorganic and Medicinal Chemistry, 1999) is maintained for reasons already made of record. Applicants argue that compound 8a in the reference has a 4-cyanophenyl substituted imidazole group whereas the substituents on the heteroaryl moiety in the present application is limited to those defined on page 5, line 24, to page 6, line 3, including phenyl and phenylalkyl. The specification does not disclose whether the phenyl moiety is substituted or not. Since the definition of phenyl falls within the category of "aryl," the Examiner turns to the definition of "aryl." in the specification. On page 4, "Aryl" is defined as "a monovalent monocyclic or bicyclic aromatic hydrocarbon radical of 6 to 10 rings atoms which is substituted independently with one to four substituents...selected from...cyano." The definition clearly shows that it is permissible to have a cyano substitute at the 4-position of the phenyl ring. The instantly claimed subject matter still overlaps with that of the reference.


The Examiner noted that new claims 50-56 had been added. These claims are not commensurate with the scope of the amended claim 1 and therefore, require new search.

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Claim 38 recites the limitation "alkylsulfonylalkyl". There is insufficient antecedent basis for this limitation in the claim.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for official business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

Hong Liu
September 2, 2002


Mukund Shah
Supervisory Patent Examiner
Art Unit 1624